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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,480	06/20/2001	Tadao Yoshida	7217/64728	4411

7590 11/30/2005

COOPER & DUNHAM LLP  
1185 Avenue of the Americas  
New York, NY 10036

EXAMINER
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THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/885,480

Applicant(s)

YOSHIDA ET AL.

Examiner

Marissa Thein

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 12, 17-25, 27, 30-38 and 40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12, 17-25, 27, 30-38, and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 19, 2005 has been entered.

### ***Response to Amendment***

Applicants' "Amendment..." filed on September 19, 2005 has been considered with the following effect.

Claims 13-16, and 28-29 are canceled. Claims 1, 17 and 30 have been amended. Claims 1-10, 12, 17-25, 27, 30-38, and 40 remain pending in this application and an action on the merits follow.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claim 1, 12, 17, 27, 30, and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,018,720 to Fujimoto.**

Regarding claim 1, Fujimoto discloses an information distribution system having a terminal apparatus in which a recording medium has recorded thereon an identifier unique to the recording medium and unrewritable prepaid information (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48) and is loadable in an information center that is connectable to the terminal apparatus and transmits content data thereto via a predetermined communication line (see at least Figure 1; Figure 2; col. 2, lines 46-65), the terminal apparatus comprising:

- first receiving means for receiving the content data transmitted from the information center (see at least col. 2, lines 46-65; col. 3, lines 1-4; col. 8, lines 61-66);
- recording and reproducing means for recording the content data received by the first receiving means onto the recording medium loaded by a purchaser in the terminal apparatus and reproducing the identifier unique to the recording medium (see at least col. 2, lines 46-65; col. 3, lines 1-35; col. 9, lines 40-55; col. 13, lines 4-47) and the unrewritable prepaid information, wherein the unrewritable prepaid information includes a prepaid amount of money, a prepaid service ID and a medium ID (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48; col. 10, lines 40-46; col. 13, lines 4-47);
- first transmitting means for transmitting the reproduced identifier unique to the recording medium and the reproduced unrewritable prepaid information (col. 3,

Art Unit: 3627

lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48) to the information center (see at least col. 3, lines 1-35; col. 9, lines 40-64; col. 6, lines 41-58);

- the information center comprising:
- first storage means for storing a plurality of content data (see at least col. 8, lines 16-24; Figure 1; col. 6, lines 22-23);
- second transmitting means for transmitting predetermined content data from the first storage means to the terminal apparatus (see at least col. 6, lines 23-38);
- second receiving means for receiving the identifier unique to the recording medium and the unrewritable prepaid information (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48) transmitted from the terminal apparatus (see at least col. 6, lines 23-58; col. 13, line 63 – col. 14, line 5);
- second storage means for storing a usable remaining amount of money relative to the unrewritable prepaid information (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48) in accordance with the identifier unique to the recording medium and the unrewritable prepaid information (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48) received by the second receiving means (see at least col. 9, lines 56-col. 10, line 3; col. 13, line 63-col. 14, line 5); and
- charging processing means for updating, when the predetermined content data are transmitted from the first storage means to the terminal apparatus, the usable remaining amount of money stored in the second storage means for a charge of the predetermined content data transmitted from the first storage means to the

terminal apparatus (see at least col. 3, lines 11-23; col. 8, line 63 – col. 9, line 5; col. 9, lines 56-col. 10, line 3; col. 13, line 63-col. 14, line 5).

Regarding claim 12, Fujimoto discloses wherein communication destination identifying information for connecting the terminal apparatus to the information center is also recorded on the recording medium (see at least col. 3, lines 46-51; col. 13, lines 4-18).

Regarding claims 17, Fujimoto discloses an information center, connected to a terminal apparatus via a predetermined communication line, for distributing content data, comprising:

- first storage means for storing a plurality of content data (see at least col. 6, lines 22-25);
- transmitting means for transmitting predetermined content data from said first storage means to said terminal apparatus (see at least col. 3, lines 24-36; col. 8, lines 16-24; col. 16, lines 9-19);
- receiving means for receiving an identifier unique to a recording medium loaded by a purchaser in the terminal apparatus and unrewritable prepaid information (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48; col. 10, lines 22-24) stored therein transmitted from said terminal apparatus (see at least col. 3, lines 24-36; col. 8, lines 16-24; col. 16, lines 9-19), wherein the unrewritable prepaid information includes a prepaid amount of money, a prepaid service ID, and medium ID (col. 10, lines 41-46; col. 13, lines 4-47);

Art Unit: 3627

- second storage means for storing a usable remaining amount of money in accordance with said identifier unique to said recording medium and said unrewritable prepaid information (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48) received by said receiving means (see at least col. 3, lines 4-23; col. 8, line 57 – col. 9, line 5; col. 9, lines 21-29);
- charging processing means for updating, when said predetermined content data are transmitted from said first storage means to said terminal apparatus, said usable remaining amount of money stored in said second storage means for a charge of said predetermined content data transmitted from said first storage means to said terminal apparatus (see at least col. 3, lines 11-23; col. 8, line 63 – col. 9, line 5; col. 9, lines 56-col. 10, line 3; col. 13, line 63-col. 14, line 5).

Regarding claim 27, the claim recites an information center connected to a terminal apparatus that is parallel in scope to claim 12 above and is rejected under similar grounds.

Regarding claim 30, Fujimoto discloses information distribution method for distributing content data from an information center to a terminal apparatus in which a recording medium is loadable and recording the distributed content data thereto, said information center and said terminal apparatus being interconnected via a predetermined communication line, comprising the steps of:

- receiving an identifier unique to said recording medium and unrewritable prepaid information (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48; col. 10, lines 22-24) recorded on said recording medium loaded by a purchaser in the

Art Unit: 3627

terminal apparatus and transmitted from said terminal apparatus (see at least col. 6, lines 23-58; col. 13, line 63 – col. 14, line 5), wherein the unrewritable prepaid information includes a prepaid amount of money, a prepaid service ID and a medium ID (col. 10, lines 41-46; col. 13, lines 4-47);

- storing, in a memory, a usable remaining amount of money relative to the unrewritable prepaid information (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48) in accordance with said received identifier unique to said recording medium and said received unrewritable prepaid information (col. 3, lines 12-14; col. 5, lines 38-41; col. 8, lines 34-48; col. 3, lines 4-23; col. 8, line 57 – col. 9, line 5; col. 9, lines 21-29);
- comparing said usable remaining amount of money stored in said memory with a charge of content data to be distributed from said information center to said terminal apparatus (see at least col. 3, lines 11-23; col. 8, line 63 – col. 9, line 5; col. 9, lines 56-col. 10, line 3; col. 13, line 63-col. 14, line 5);
- permitting, when said usable remaining amount of money stored in said memory is greater than said charge of said content data to be distributed from said information center to said terminal apparatus, the transmission of said content data from said information center to said terminal apparatus (see at least col. 3, lines 11-23; col. 8, line 63 – col. 9, line 5; col. 9, lines 56-col. 10, line 3; col. 13, line 63-col. 14, line 5); and
- updating, by said charge of said content data, said usable remaining amount of money stored in a second memory when said content data are transmitted from



Art Unit: 3627

said information center to said terminal apparatus (see at least col. 3, lines 11-23; col. 8, line 63 – col. 9, line 5; col. 9, lines 56-col. 10, line 3; col. 13, line 63-col. 14, line 5).

Regarding claim 40, the claim recites a method that is parallel in scope to claim 12 above and is rejected under similar grounds.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2-3, 18 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,018,720 to Fujimoto in view of U.S. Patent No. 6,144,745 to Akiyama et al.**

Regarding claim 2, Fujimoto substantially discloses the claimed invention, however, it does not disclose the recording medium also records information about a remaining recordable capacity thereof, the information is reproduced by the recording and reproducing means, the reproduced information is transmitted by the first transmitting means to the information center. Fujimoto discloses the purchaser may increase the number of game software recorded therein within storage or memory capacity thereof (col. 9, lines 12-15). Furthermore, Fujimoto discloses blocks of data purchased by the purchaser (see at least col. 10, lines 19-21). Akiyama, on the other

hand, teaches the recording medium also records information about a remaining recordable capacity (see at least col. 6, lines 57-64).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of Fujimoto, to includes the recording of the remaining recording capacity, as taught by Akiyama, so as to be notified as to whether there is left a capacity enough to store the data (Akiyama col. 6, lines 60-61).

Regarding claim 3, Fujimoto substantially discloses the claimed invention, specifically, the first comparing means for comparing usable remaining amount of money stored in the second storage means with a price of content data to be transmitted to the terminal apparatus (see at least col. 8, line 66- col. 9, line 3; col. 9, lines 56-64). However, Fujimoto does not disclose the second comparing means for comparing the information about a remaining recordable capacity of the recording medium with a size of the content data to be transmitted to the terminal apparatus. Fujimoto discloses the purchaser may increase the number of game software recorded therein within storage or memory capacity thereof (col. 9, lines 12-15). Akiyama, on the other hand, teaches the second comparing means for comparing the information about a remaining recordable capacity of the recording medium with a size of the content data to be transmitted to the terminal apparatus (see at least col. 6, lines 57-64).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of Fujimoto, to includes the recording of the remaining recording capacity, as taught by Akiyama, so as to be

Art Unit: 3627

notified as to whether there is left a capacity enough to store the data (Akiyama col. 6, lines 60-61).

Regarding claim 18, the claim recites an information center connected to a terminal apparatus that is parallel in scope to claim 3 above and is rejected under similar grounds.

Regarding claim 31, the claim recites a method that is parallel in scope to claim 3 above and is rejected under similar grounds.

**Claim 4-10, 19-25 and 32-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,018,720 to Fujimoto and U.S. Patent No. 6,144,745 to Akiyama et al. and further in view of U.S. Patent No. 6,539,468 to Inoue et al.**

Regarding claims 4-10, the combination of Fujimoto and Akiyama substantially disclose the claimed invention, however, it does not disclose the prompt for the loading of a second recording medium recording; adding means for adding; the edition based on the information about the remaining recordable capacity of the previously loaded recording medium and the information about the remaining recordable capacity of the second recording medium; when the remaining recordable capacity is found by the second comparing means to be smaller than the size of content data to be transmitted to the terminal apparatus, a control signal is transmitted from the information center to the terminal apparatus to instruct; the terminal apparatus to prompt for the loading of a second recording medium recording the remaining recordable capacity of the second recording medium is compared with the size of the content data to be transmitted to the

Art Unit: 3627

terminal apparatus; and, contents recorded on the second storage means are updated.

The combination discloses the purchaser may increase the number of game software recorded therein within storage or memory capacity thereof (Fujimoto col. 9, lines 12-15). Furthermore, the combination discloses the remaining recordable capacity (Akiyama see at least col. 6, lines 57-64),

Inoue, on the other hand, teaches the prompt for the loading of a second recording medium recording; adding means for adding; the edition based on the information about the remaining recordable capacity of the previously loaded recording medium and the information about the remaining recordable capacity of the second recording medium; and, contents recorded on the second storage means are updated (see at least col. 1, lines 38-57; col. 2, lines 16-34).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination, to include the prompting, adding, editing, and the updating, as taught by Inoue, in order to providing copying control information recorded on a first recording medium onto a second recording medium (Inoue col. 1, lines 38-45).

Regarding claims 19-25, the claims recite an information center connected to a terminal apparatus that is parallel in scope to claims 4-10 above and are rejected under similar grounds.

Regarding claims 32-38, the claims recite a method that is parallel in scope to claims 4-10 above and are rejected under similar grounds.

### ***Response to Arguments***

Applicant's arguments filed September 19, 2005 have been fully considered but they are not persuasive.

Applicants remark that "Fujimoto fails to show or suggest that prepaid information is recorded in a purchaser recording medium in an unrewritable manner".

The Examiner does not agree. Fujimoto discloses a purchaser's record medium, which can record primary data, which includes software and additional data (col. 2, lines 51-54). The additional data includes purchaser's inherent data, purchase history data representing history of purchase of the primary data to be purchased by the purchaser, and accounting data (col. 3, lines 5-8). The additional data is added to the purchaser record medium by a block each time, and the past payment history is preserved and the additional data is not updated (col. 15, lines 17-20). A storage area of the purchaser's record medium is composed of: a rewritable area Z1 for storing primary data such as software and data in such a manner as to be able to rewrite or replace currently recorded software and data; a purchaser history data area Z2, and a purchaser's inherent-data/accounting data area Z3 (col. 9, lines 21-29). The purchaser history data are accumulated therein without updating the past purchase history data (col. 10, lines 22-24). The accounting data are accumulated without updating the past purchaser history data (col. 11, lines 38-40). Furthermore, Fujimoto discloses software deliverers deliver original primary data, namely original software such as programs, image data, value-added data for controlling and expanding operations and functions of machines. The software deliverers manage data recorded in the computers by using authentication functions individually. The authentication function is performed using an identification

Art Unit: 3627

number and a password that are allocated to each of the software deliverers. Thus, even when a purchaser tries to access directly to the computer of the software deliverer, it is substantially impossible to tamper and download the data recorded therein. The databases which are unique to the software deliverers but are not open to the public, are constructed in the computers. (Col. 8, lines 34-44) Fujimoto discloses a regulating means for imposing restrictions on the rewriting of original data, which is recorded in the software-deliverer-side recording means by the purchaser (col. 6, lines 38-41):

Such record medium which can record original primary data and additional data, and the additional data is purchaser's inherent data, purchase history data representing history of purchase of the primary data to be purchased by the purchaser, and accounting data which is accumulated and preserved, not updated are considered prepaid information which is recorded in a recording medium in an unrewritable manner.

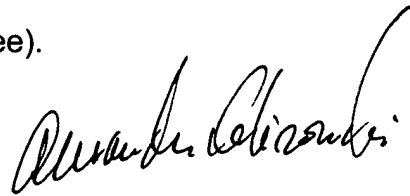
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**ALEXANDER KALINOWSKI**  
**SUPERVISORY PATENT EXAMINER**

Mtot  
November 26, 2005